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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT PAPER NUMBER

1616

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/843,000	Applicant(s) PAGANO ET AL.	
	Examiner Sharmila S. Gollamudi	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 58-60 is/are pending in the application.
4a) Of the above claim(s) 37-57 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 58-60 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt of Request for Continued Examination and Amendments filed 3/1/05 is acknowledged.

Claims 58-60 are pending in this application. Claims 37-57 are withdrawn from consideration.

Election/Restrictions

Newly submitted claims 37-57 directed to an invention that is independent or distinct from the invention **originally** claimed for the following reasons:

- I. Claims 37-57 drawn to method of making an anhydrous nail enamel.
- II. Claims 58-60, drawn to a anhydrous nail enamel.

Claims 37-57 are directed to a method of making an anhydrous nail enamel inventions and claims 58-60 are directed to the original invention, an anhydrous nail composition. In the instant case, claims 37-57 are directed to a process of making a nail composition wherein the process involves copolymerizing the different monomers and then blending the copolymer solution with a pigment and plasticizer. However, claims 58-60 are directed to a *different* anhydrous nail composition that comprises a copolymer and solvent. Claims 58-59 do not require a pigment and claim 60 excludes a pigment. Therefore, it can be seen that although the method claim recite a “method of making an anhydrous nail enamel”, this nail enamel is not the anhydrous nail enamel composition of claims 58-60. Moreover, the method claims recite specific steps that are not required in the nail enamel composition, such as copolymerizing the monomers in a separate step and adding pigments.

It should be further noted that applicant may not switch inventions after filing of an RCE, as a matter of right. See MPEP 706.07.

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Specification

The amendment filed 3/1/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment recites 5-95% solvent, which does not find support in the specification as originally filed. Further, applicant asserts this is an error since if the composition contains 95% of a copolymer, then it cannot contain the originally claimed 10% solvent. The examiner points out that this does not constitute an obvious error and is considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 58-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Original claims recited 10-95% solvent. The amendment of 3/1/05 recites 5-95% solvent, which does not find support in the specification as originally filed. Further, applicant asserts this is an error since if the composition contains 95% of a copolymer, then it cannot contain the

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originally claimed 10% solvent. The examiner points out that this does not constitute an obvious error and is considered new matter.

The amendment of 3/1/05 recites wherein said copolymer is uniformly dispersed in said enamel and is not present solely as a coating on a pigment, which does not find support in the specification as originally filed.

The amendment of 3/1/05 recites the copolymer in a range of 71-98% which does not find support in the instant specification.

The amendment of 3/1/05 recites “wherein the copolymer is substantially free of anhydride monomers, ureido monomers, acid monomers in combination with hydroxymonomers, and monomers containing acetoacetoxy moieties”, which does not find support in the originally claimed specification. It should be noted that upon further consideration the recitation of “free of acetoacetoxy moieties” is also considered new matter. MPEP 2173.05 (I) states “(a)ny negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily the part remaining.”) See also *Ex parte Grassell*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion, i.e. the mere absence of the monomers in the examples is not enough basis for exclusion of said monomers. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. With regard to the instant invention, the contemplation of inclusion or exclusion of said monomers has not been

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located in the specification. Ex parte Grasselli states “the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded. This clearly illustrates that such negative limitations do, in fact, introduce new concept.” (394).

Thus, the new amendments of 3/1/05 are rejected under 35 USC 112, first paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 58 is under 35 U.S.C. 102(b) as being anticipated by Perronin et al (3,991,007).

Perronin discloses the preparation of pigmentary particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The methacrylate-acrylic acid copolymer is 70-30. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% instant copolymer) with 86 parts nitrocellulose resin, 210 parts ethyl acetate, 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer). Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20. Suitable solvents include ethers and esters. See column 2, lines 60-62.

Note that the preamble “nail enamel composition” does not hold since it does not denote any structural limitation to the composition itself.

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Response to Arguments

Applicant argues that Perronin et al do not teach the instant, which has two distinct steps. Applicant argues that claims have been amended to recite that the copolymer is uniformly dispersed.

Applicant's arguments filed 3/1/05 have been fully considered but they are not persuasive. It should be noted that the process claims have been restricted out and thus arguments pertaining to the process of making anhydrous nail enamel are moot.

With regard to the amendments, firstly it should be noted that this amendment is rejected under new matter. Secondly, the examiner points out that Perronin does in fact teach the dispersion of the pigment composition in the final media, so even if the amendment had support, Perronin still constitutes prior art. Thirdly, with regard to the recitation "not present solely as a coating on a pigment", the examiner points out that the applicant is claiming a product wherein the function of each individual component is not given patentable weight. Moreover, the prior art and the instant invention have the same amount of the copolymer claimed.

Claims 58 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated Pagano et al (5772988).

Pagano et al disclose a nail composition containing approximately 62% butyl acetate (solvent), 25.70% of a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, stearalkonium bentonite, silicone glycol copolymer, and a plasticizer (glyceryl tribenzoate). See example 1. Example 2 discloses a nail enamel containing 17.83% butyl acetate (glycol ester solvent), 60% of a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, 1.05%

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stearalkonium bentonite, 2% dipropylene glycol dibenzoate. Monomer A (ethylenically unsaturated monomer) is in the amount of 30-95%, monomer B (acetoacetoxy moieties) in the amount of 5-50%, and monomer C (acrylic acid) in the amount of 1-20%. Note column 5, lines 24-29. Monomer B is contained in 20% in the examples. The examples disclose both pigmented and unpigmented nail compositions. The composition can be in a kit (Note example 1) with a cellulose polymer.

*Note that since the applicant has not defined "substantially free" in the specification, it is the examiner's position that less than 50% reads on "substantially free."

Claims 58 is rejected under 35 U.S.C. 102(b) as being anticipated Hosotte-Filbert et al et al (5,681,877).

Hosotte-Filbert et al disclose a composition containing a 5% of a copolymer containing 22% acrylic acid (pAA) and 78% methyl methacrylate (pMMA), 20% of a pigment, 5% nitrocellulose (film-former), and 70% butyl acetate (solvent). See example 1 and 8.

Note the preamble does not hold patentable weight.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 58 is rejected under 35 U.S.C. 102(e) as being anticipated by Bednarek et al (6,254,878).

Bednarek et al disclose a nail polish composition containing acrylic polymers. Example 1 discloses a dispersion comprising titanium dioxide or red iron oxide pigment (pigment), bentonite clay (suspending agent), butyl acetate solvent, and 40% acrylic polymer (20/70/10 wt. % butylmethacrylate-co-methacrylate-co-acrylic acid). The dispersions are then mixed with 701

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grams of a 40 solution of butylmethacrylate-co-methacrylate-co-acrylic acid (20/70/10 wt. %) in butyl acetate and ethyl acetate solvent and 70 grams of butyl cellosolve.

Response to Arguments

Applicant argues that the instant amendments overcome Bednarek.

Applicant's arguments filed 3/1/05 have been fully considered but they are not persuasive. Firstly, it should be noted that the amendments are rejected under new matter. Secondly, the examiner points out that even if applicant provides support for the amendment, Bednarek still constitutes prior art. Bednarek teaches of butylmethacrylate-co-methacrylate-co-acrylic acid, which reads on the instant copolymer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bednarek et al (6,254,878).

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Bednarek et al disclose a nail polish composition containing acrylic polymers. Example 1 discloses a dispersion comprising titanium dioxide or red iron oxide pigment (pigment), bentonite clay (suspending agent), butyl acetate solvent, and 40% acrylic polymer (20/70/10 wt. % butylmethacrylate-co-methacrylate-co-acrylic acid). The dispersions are then mixed with 701 grams of a 40% solution of butylmethacrylate-co-methacrylate-co-acrylic acid (20/70/10 wt. %) in butyl acetate and ethyl acetate solvent and 70 grams of butyl cellosolve. Bednarek teaches clear coat nail polish that contains a solvent system and a film forming acrylic polymer binder and a colored nail polish formulation wherein the composition contains the solvent, pigment, pigment dispersant, and a binder which is preferably an acrylic polymer. See column 2, lines 55-64.

Bednarek does not exemplify an unpigmented nail composition with the of copolymer butylmethacrylate-co-methacrylate-co-acrylic acid.

It would have been obvious to one of ordinary skill in the art at time the invention was made to look at the guidance provided by Bednarek and exclude a pigment from the nail composition in example 1. One would have been motivated to do so since Bednarek teaches clear nail polish only requires a solvent system and a film former. Therefore, it would have been obvious to exclude the pigment dispersion in example 1 to yield a clear nail polish as presently claimed.

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perronin et al (3,991,007) in view of Hosotte-Filbert et al et al (5,681,877).

Perronin discloses the preparation of pigmentary particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note

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column 1, lines 10-12. Example 6 provides a composition with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. The methacrylate-acrylic acid copolymer is 70-30. The pigment composition D is then combined in an amount of 190 parts (50% pigment and 50% instant copolymer) with 86 parts nitrocellulose resin, 210 parts ethyl acetate, 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer).

Example 13 teaches a copolymer of methyl methacrylate and acrylic acid in the amount of 80-20.

Suitable solvents include ethers and esters. See column 2, lines 60-62.

Although Perronin teaches methyl methacrylate-acrylic acid copolymer, Perronin does not teach the instant butyl methacrylate-acrylic acid copolymer. Secondly, Perronin does not teach the use of a suspending agent.

Hosotte-Filbert et al teach the use of block polymers (acrylic acid and methyl methacrylate) as dispersing agents of pigments in cosmetics. See abstract. Conventional nail varnish bases utilized contain 10-15% nitrocellulose, 8-12% filler resin, 6-8% plasticizer, 65-75% solvents, 0.8-1.5% suspending agent, and the pigment is added depending on the desired color. See example 9.

Firstly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to look at the guidance provided by Perronin and utilize either methyl methacrylate or instant butyl methacrylate since both are alkyl acrylates with 1-12 carbons. Therefore, absent unexpected results, substituting the prior art's methyl with instant butyl, is deemed obvious to a skilled artisan.

Secondly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize conventional additives such as a suspending agents in a

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conventional varnish base. One would have been motivated to do so since Hosotte-Filbert teaches conventional nail varnish base contains plasticizers, suspending agents, solvents, resins, etc. Therefore, one would have been motivated to look to Hosotte-Filbert if one wanted to utilize Perronin's pigment in a nail composition. Further, one would expect similar results since Perronin teaches the pigmented composition may be used in cosmetics. Lastly, absent the unexpectedness of the instant plasticizer and suspending agent, the use of the instant plasticizer and suspending agent is deemed obvious since bentonite is a routinely utilized suspending agent in the art and dipropylene dibenzoate is a conventional plasticizer used in the art.

Conclusion

All the claims are rejected at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

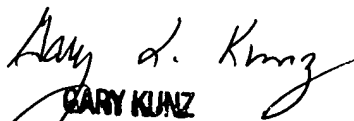
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Sharmila S. Gollamudi

Examiner

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